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Remarks

Claims 1 to 49 are pending. Claims 32-37 have been canceled. Claims 8, 18, 25, 30, 31 38-42, 45 and 48 are amended.

Double Patenting

Applicants note the various provisional double patenting rejections and provisional obviousness-type rejections, but will not address such rejections until claims from the co-pending patent applications are allowed or issued.

§ 102 Rejections

Claims 25-49 stand rejected under 35 USC § 102(a) as being anticipated by Garber et al. (US 6,232,870).

Claims 25-31: Claims 25 and 30 have been amended to help clarify the invention. Claim 25 has been amended to recite in step c) "providing an indication to a user when the RFID reader interrogates an RFID tag associated with an item that does not match an entry on the database." Claim 30 has been amended to recite "wherein the user interface enables a user to create a database record for the item that does not match an entry on the database." Claim 31 has been amended to recite "wherein the user interface enables a user to enter information into the RFID reader related to the item that does not match an entry on the database." Support for these amendments can be found in the specification, for example on page 5, lines 5-20.

Applicants believe independent claim 25, as amended, is allowable over Garber et al. Garber et al. does not disclose the step of providing an indication to a user the RFID reader interrogates an RFID tag that does not match an entry on the database. One non-limiting example of the method steps recited in claim 25 is illustrated in the specification starting on page 5, lines 5 to 14. For example, during data collection, the RFID reader may provide audible and/or visual feedback to indicate when the RFID reader detects an RFID tag that does not match an entry on an existing database. For example, a lighted indicator may indicate that an RFID tag has been interrogated that does not match an entry on an existing database of items. The benefit of this feature is to alert a user when an article, for example a book, is interrogated and an entry on the database indicates the book's status is checked out, or the book is not found on the

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library's database of books, and thus, the book might be from another library or for some other reason, it is not recorded on their database system. Understandably, it is important that your database is complete in that it includes your entire inventory of books or items and that they be properly recorded, and that the status of each item of the inventory, such as its availability to be checked out, is correct. Otherwise, you might have books or items in your library that are not recorded properly in the system.

In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, line 32 and ending on column 18, line 54, where there is no teaching of indicating to a user when the RFID reader interrogates an RFID tag associated with an item that does not match an entry on the database. Instead, Garber only teaches interrogating items that are already recorded as entries on the database, and then performing various functions, methods and applications.

In addition, Garber does not teach illuminating a light source or providing an audible signal or providing an indication on the display when the RFID reader interrogates an RFID tag associated with an item that does not match an entry on the database. (Claims 26-28) Lastly, Garber et al. does not teach allowing a user to create a new database record or enter information into the RFID reader related to the item that does not match an entry on the database. (Claims 30-31) Therefore, claims 26-28 and claims 30-31 are independently allowable for these reasons.

Therefore, claim 25, as amended, recites elements not disclosed by Garber et al. and should be allowable. Claims 26-31, which depend from claim 25 and add further limitations, should also be allowable. Claims 26-28 and claims 30-31 also recite elements that are not disclosed by Garber et al. and thus should be independently allowable. Therefore, Applicants respectfully request the rejection of claims 25-31 under 35 U.S.C. § 102(a) over Garber et al. be withdrawn.

Claims 32-37: Claims 32-37 have been canceled without prejudice to their underlying subject matter, rendering the present rejection moot.

Claim 38: Claim 38 has been amended to recite in step (b) "simultaneously using the information obtained in step (a) for determining the presence or absence of the items in the storage area." Support for this amendment can be found in the specification, for example on page 7, lines 4-25.

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Applicants believe independent claim 38, as amended, is allowable over Garber et al.

Garber et al. does not disclose the steps of:

- (a) interrogating RFID tags, each associated with an item, to obtain information related to the items for a purpose other than determining the presence or absence of the items in a storage area; and
- (b) simultaneously using the information obtained in step (a) for determining the presence or absence of the items in the storage area.

One non-limiting example of the method steps recited in claim 38, as amended, is illustrated in the specification starting on page 7, lines 4 to 25:

In another embodiment of the present invention, For example, inventory may be conducted simultaneously with other operations of the RFID system. That is, it is known to conduct inventory of RFID-tagged items by interrogating the items for that purpose. In this embodiment of the present invention, inventory is conducted as a background operation of the RFID system, using data acquired for a different purpose. For example, a portable RFID reader may be used to interrogate items in a storage area to determine whether they are located in the proper order, location, or both, or whether they are present on a list of items in which the user is interested. This would be the primary purpose of the RFID interrogation, but the information obtained regarding those items may also be used to conduct inventory. That is, each RFID-tagged item that is interrogated to determine whether it is in the proper order relative to adjacent items is necessarily also present in the storage area, and thus an inventory database can be consulted and updated, as needed, to reflect the fact that the item is present. This background inventory operation may also be used with other RFID hardware, such as check-in/check-out devices, conversion stations (for converting items without RFID tags to items with RFID tags, the tags being associated with the items), or other such devices. In those instances, the primary operation may be to check an item into or out of a storage area, or to convert an item to an RFID-tagged item, but inventory (the secondary operation) can also be conducted in the background, perhaps to notify a user if the items presented for conversion are not presented in the expected order according to an order list of items.

In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, line 32 and ending on column 18, line 54, where there is no teaching of performing simultaneous multiple operations, such as using the same information that is collected to determine for a purpose other than determining the presence or absence of the items in a storage area to simultaneously conduct inventory (i.e. determining the presence or absence of items).

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Therefore, claim 38, as amended, recites elements not disclosed by Garber et al. and should be allowable. Therefore, Applicants respectfully request the rejection of claim 38 under 35 U.S.C. § 102(a) over Garber et al. be withdrawn.

Claim 39: Claim 39 has been amended to recite in step (b) “simultaneously using information obtained in step (a) for a second purpose of determining the presence or absence of the items in the storage area.” Support for this amendment can be found in the specification, for example on page 7, lines 4-25.

Applicants believe independent claim 38, as amended, is allowable over Garber et al. Garber et al. does not disclose the steps of:

- (a) interrogating RFID tags, each associated with an item, to obtain information for a first purpose of determining whether the items are in a predetermined order within a storage area; and
- (b) simultaneously using information obtained in step (a) for a second purpose of determining the presence or absence of the items in the storage area.

One non-limiting example of the method steps recited in claim 39 is illustrated in the specification starting on page 7, lines 4 to 25, which is reproduced above in the section on claim 38.

In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, line 32 and ending on column 18, line 54 where there is no teaching of performing simultaneous multiple operations, such as using the same information that is collected to determine whether the items are in a predetermined order within the storage area to simultaneously conduct inventory (i.e. determining the presence or absence of items).

Therefore, claim 39, as amended, recites elements not disclosed by Garber et al. and should be allowable. Therefore, Applicants respectfully request the rejection of claim 39 under 35 U.S.C. § 102(a) over Garber et al. be withdrawn.

Claim 40: Claim 40 has been amended to recite in step (b) “simultaneously using the information obtained in step (a) for a second purpose of determining the presence or absence of the items in the storage area.” Support for this amendment can be found in the specification, for example on page 7, lines 4-25.

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Applicants believe independent claim 40, as amended, is allowable over Garber et al.

Garber et al. does not disclose the steps of:

- (a) interrogating RFID tags, each associated with an item, to determine information related to the items for a first purpose of searching for certain items on a predetermined search list; and
- (b) simultaneously using the information obtained in step (a) for a second purpose of determining the presence or absence of the items in the storage area.

One non-limiting example of the method steps recited in claim 40 is illustrated in the specification starting on page 7, lines 4 to 25, which is reproduced above in the section on claim 38.

In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, line 32 and ending on column 18, line 54 where there is no teaching of performing simultaneous multiple operations, using the same information that is collected for a first purpose of searching for certain items on a predetermined search list to simultaneously conduct inventory (i.e. determining the presence or absence of items).

Therefore, claim 40, as amended, recites elements not disclosed by Garber et al. and should be allowable. Therefore, Applicants respectfully request the rejection of claim 40 under 35 U.S.C. § 102(a) over Garber et al. be withdrawn.

Claim 41: Claim 41 has been amended to recite in step (b) "simultaneously using the information obtained in step (a) for a second purpose of determining the presence or absence of the items in the storage area." Support for this amendment can be found in the specification, for example on page 7, lines 4-25.

Applicants believe independent claim 41, as amended, is allowable over Garber et al.

Garber et al. does not disclose the steps of:

- (a) interrogating RFID tags, each associated with an item, to determine information related to the items for a first purpose of checking items into or out of a storage area; and
- (b) simultaneously using the information obtained in step (a) for a second purpose of determining the presence or absence of the items in the storage area.

One non-limiting example of the method steps recited in claim 41 is illustrated in the specification starting on page 7, lines 4 to 25, which is reproduced above in the section on claim 38.

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In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, line 32 and ending on column 18, line 54 where there is no teaching of performing simultaneous multiple operations, using the same information that is collected to for a first purpose of checking items into or out of a storage area to simultaneously conduct inventory (i.e. determining the presence or absence of items).

Therefore, claim 41, as amended, recites elements not disclosed by Garber et al. and should be allowable. Therefore, Applicants respectfully request the rejection of claim 41 under 35 U.S.C. § 102(a) over Garber et al. be withdrawn.

Claims 42-47: Claims 42 and 45 have been amended to help clarify the inventions. Claim 42 has been amended to recite in step (d) "enabling the user to correct the inventory list in real time by confirming that the item is present using a user interface associated with the RFID reader." Claim 45 has been amended to recite in step (d) "enabling the user to correct the inventory list in real time by confirming that the item is absent using a user interface associated with the RFID reader." Support for this amendment can be found in the specification, for example on page 8, lines 9 to 34.

Applicants believe independent claims 42 and 45, as amended, are allowable over Garber et al. Specifically, claim 42 is directed towards indicating to a user in real time that the inventory list indicates that the item is *absent*; and then enabling the user to correct the inventory list in real time by confirming that the item is *present* using a user interface associated with the RFID reader. Claim 45 is directed towards indicating to a user in real time that the inventory list indicates that the item is *present*; and enabling the user in real time to correct the inventory list by confirming that the item is *absent* using a user interface associated with the RFID reader. Some non-limiting examples of the method steps recited in claims 42 and 45 are illustrated in the specification starting on page 8, lines 9 to 34:

In a related embodiment of the invention, a portable RFID reader performs real-time inventory reconciliation. That is, the portable RFID reader reads the RFID tags of items located in a storage area, such as on a shelf, and then compares the list of items detected with the expected contents of the storage area based on data stored in an inventory database. Real time inventory information can be provided to a user regarding items that should have been found but were not, items that should not have been found but were, or other discrepancies between the actual inventory and the inventory reflected on the database. The status of an item could be updated based on the information obtained

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from the interrogation, and the new status could be stored in the inventory database. A particularly useful feature of real-time inventory is for the RFID reader to enable the user to confirm, during interrogation, that a particular item that was not found (but was expected to have been found) is missing from the storage area. If the user confirms that the item is missing, then the RFID reader can correct the inventory database to indicate that the item is missing (that is, not present). The reverse may also be useful – enabling the user to confirm that a particular item that was found but was thought to be missing is actually present, and thus to correct the inventory database. The corrected inventory database may be stored wherever the original inventory database was stored. This real-time reconciliation of inventory saves time, and thus is a useful feature in inventory work.

In contrast, Garber et al. does not teach indicating to a user in real time that the inventory list indicates that the item is *absent*; and then enabling the user in real time to correct the inventory list by confirming that the item is *present* using a user interface associated with the RFID reader (claim 42), nor does Garber et al. teach indicating to a user in real time that the inventory list indicates that the item is *present*; and enabling the user in real time to correct the inventory list by confirming that the item is *absent* using a user interface associated with the RFID reader (claim 45). In contrast, claims 1, 11, and 12 of Garber et al., which were cited by the Examiner against claim 42, only teach determining whether the certain item is present or belongs with a group of items and then indicating such determination to the user in real time. Garber et al. does not teach enabling the user in real time to correct the inventory base by confirming that the item is present or absent.

Therefore, claims 42 and 45, as amended, recite elements not disclosed by Garber et al. and should be allowable. Claims 43-44, which depend from claim 42 and add further limitations, should also be allowable. Claims 46-47, which depend from claim 45 and add further limitations, should also be allowable. Therefore, Applicants respectfully request the rejection of claims 42-47 under 35 U.S.C. § 102(a) over Garber et al. be withdrawn.

Claim 48: Claim 48 has been amended to help clarify the invention. Claim 48 has been amended to recite a method of organizing collected data related to items associated with RFID tags. Support for this amendment can be found in the specification, for example on page 9, lines 8 to 27.

Applicants respectfully disagree with the Examiner's rejection of claim 48, as amended, under 35 U.S.C. § 102(a) over Garber et al. for the following reasons.

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First, in regard to claim 48, the support for the anticipation rejection in the Office Action is portions of issued claims 6 and 7 of Garber, which is not sufficient under the current law. MPEP §2131 states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ...The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Claim 48 of the present application did not match the issued claims 6 and 7 of Garber, and without more explanation, there is insufficient support for an anticipation rejection. Therefore, the rejection is unsupported by the art and should be withdrawn.

Second, Garber does not teach the method of claim 48. Claim 48 recites a method of organizing collected data related to items associated with RFID tags, comprising the steps of:

- (a) using an RFID reader to interrogate RFID tags, each associated with an item, wherein the items are not arranged or interrogated in an order associated with their desired locations in a storage area;
- (b) organizing information obtained from the RFID tags in an order associated with the desired locations of the items in a storage area; and
- (c) providing the organized information from step (b) to a user.

One non-limiting example of the method steps recited in claim 48 is illustrated in the specification starting on page 9, lines 8 to 27:

In libraries and other storage areas, considerable effort can be expended returning items to a storage area after use. These items generally must be put back into the proper location. Often this is done by manually sorting the items onto a cart, then traversing the storage area, taking the ordered items from the cart and replacing them on, for example, the shelves of the storage area. Automated assistance for this task is the purpose of the following embodiment of the present invention. In this embodiment, a portable RFID reader can be used to read the RFID tags associated with each of a set of randomly placed items and display a list of those items according to a predetermined order. The order may be a standard order for organizing items of that type (such as the Dewey Decimal system or the Library of Congress system for organizing materials in a library), or a customized order. When the RFID reader interrogates the random set of RFID-tagged items, the reader can organize information about those items in order, and then display either a part of or all of the list of ordered items. The information displayed in the list could be information obtained from the interrogated RFID tags, information obtained from a database, or a combination thereof. The list could be used to place the items in a storage area in the proper order, as with reshelving a group of library materials in their

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appropriate locations, or for placing the items on a cart for transportation to a storage area. The invention facilitates the placement of the items on the cart in the desired order, to make replacement of the items on the storage area shelves more efficient.

In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, line 32 and ending on column 18, line 54, where there is no teaching of interrogating items not arranged in a particular order, organizing the information obtained in an order associated with their desired locations of the items in a storage area, and then providing the organized information to a user. Therefore, the rejection is unsupported by the art and should be withdrawn.

Therefore, claim 48 recites elements not disclosed by Garber et al. and should be allowable. Claim 49, which depends from claim 48 and adds further limitations, should also be allowable. Therefore, Applicants respectfully request the rejection of claims 48-49 under 35 U.S.C. § 102(a) over Garber et al. be withdrawn.

Dependent Claims 26-31, 43-44, 46-47 and 49: Lastly, Applicants point out that the Examiner did not include any discussion in the Office Action regarding any of the dependent claims, claims 26-31, 43-44, 46-47 and 49. The Office Action discussion was solely focused on only the independent claims. Therefore, there is no support for the anticipation rejection against claims 26-31, 43-44, 46-47 and 49, which is insufficient under the current law. MPEP §2131 states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ...The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, the rejection against claims 26-31, 43-44, 46-47 and 49 is unsupported by art and should be withdrawn.

In summary, the rejection of claims 25-49 under 35 USC § 102(a) as being anticipated by Garber et al. has been overcome and should be withdrawn.

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§ 103 Rejections

Claims 1-17 stand rejected under 35 USC § 103(a) as being unpatentable over Garber in view of Markman (US 5,794,213).

In the Office Action, Applicants believe the Examiner recognized that Garber et al. does not disclose the steps of: (a) *selecting a category* of items using a user interface associated with an RFID reader; (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, *wherein the item of interest is not currently associated with the category selected in step (a)*; and (c) thereafter *associating information related to the at least one item obtained in step (b) with the category selected in step (a)*.

Claims 1-7: Applicants believe claims 1-7 are allowable over Garber et al. (U.S. Pat. No. 6,232,870) in view of Markman (U.S. Pat. No. 5,794,213) for the following reasons.

First, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of Markman because there is no basis for combining Garber et al.'s devices, applications, and methods of using a portable RFID device with a group of items each having an RFID tag, with Markman's system and methods of sorting laundry and dry-cleaning. There must be some suggestion in the prior art to make the combination. Absent such a showing in the prior art, the Applicants' teaching has been impermissibly used to hunt through the prior art for the claimed elements and combine them as claimed. (See, M.P.E.P. §2143.)

Second, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of Markman, because there is no reasoned statement that explains why it would have been obvious to one of ordinary skill in the art to have modified the system disclosed in Garber et al. to meet the limitations of claim 1. Instead, there is only a cursory statement that "[i]t would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Markman to the teaching of Garber . . . to relocate where the item belongs so that the item can be placed at its designated spot... ." (Office Action at page 7). Accordingly, the applied rejection is believed to be faulty, and if the Examiner proposes to provide any reasoning supporting the rejection then Applicants

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respectfully request a second non-final Office Action be issued so that Applicants may learn what that reasoning is and reply to it. (See, M.P.E.P. §2143.)

Third, even if the rejection were properly supported by argument, Applicants submit that claim 1 recites elements not shown, taught, or suggested by Garber et al. and Markman, whether taken alone or in combination. Claim 1 reads as follows:

1. A method of collecting information related to RFID tags associated with items of interest, comprising the steps of:
 - (a) selecting a category of items using a user interface associated with an RFID reader;
 - (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, wherein the item of interest is not currently associated with the category selected in step (a); and
 - (c) thereafter associating information related to the at least one item obtained in step (b) with the category selected in step (a).

Relative to Markman, the Office Action states that the group identification of each article is read by scanning a barcoded group code and article count and *the location of the group is located, which is considered as categorizing.* (emphasis added) Applicants disagree. Markman teaches that the garments to be cleaned are first categorized into a group, such as one customer's articles. Then, after the cleaning process, the garments are regrouped into their original group. Thus, the garment's category does not change. It does not matter that the garments are temporarily stored in a location while the group is being regrouped. During this process the garment's category remains the same – a group of one customer's articles. In contrast, claim 1 requires the steps of: (a) *selecting a category* of items using a user interface associated with an RFID reader; (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, *wherein the item of interest is not currently associated with the category selected in step (a);* and (c) thereafter *associating information related to the at least one item obtained in step (b) with the category selected in step (a).*

Similarly, as discussed in the Office Action faxed on November 19, 2003, Garber et al. teaches a variety of functions, methods and applications, for example starting on column 16, line

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32 and ending on column 18, line 54, *where the item of interest's category does not change* based on the function, method or application performed.

As a result, Markman or Garber et al., whether taken alone or in combination, do not teach a function, method, or application where a user is seeking to make an association between a new category and some item of interest that is not currently associated with that category, and thereafter associates the information related to the item of interest with the new category selected.

Thus, claim 1, recites elements not disclosed by Garber et al. or Markman, whether taken alone or in combination, and should be allowable. Claims 2-7, which depend from claim 1 and add further limitations, should also now be allowable. Therefore, Applicants respectfully request the rejection of claims 1-7 under 35 U.S.C. § 103(a) over Garber et al. in view of Markman be withdrawn.

Claims 8-17: Claim 8 has been amended to correct a typo. Applicants believe claims 8-17 are allowable over Garber et al. in view of Markman for the following reasons.

First, as mentioned above, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of Markman because there is no basis for combining Garber et al.'s devices, applications, and methods of using a portable RFID device with a group of items each having an RFID tag, with Markman's system and methods of sorting laundry and dry-cleaning. There must be some suggestion in the prior art to make the combination. Absent such a showing in the prior art, the Applicants' teaching has been impermissibly used to hunt through the prior art for the claimed elements and combine them as claimed. (See, M.P.E.P. §2143.)

Second, as mentioned above, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of Markman, because there is no reasoned statement that explains why it would have been obvious to one of ordinary skill in the art to have modified the system disclosed in Garber et al. to meet the limitations of claim 1. Instead, there is only a cursory statement that "[i]t would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Markman to the teaching of Garber . . . to relocate where the item belongs so that the item can be placed at its designated spot... ." (Office Action at page 7). Accordingly, the applied rejection is

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believed to be faulty, and if the Examiner proposes to provide any reasoning supporting the rejection then Applicants respectfully request a second non-final Office Action be issued so that Applicants may learn what that reasoning is and reply to it. (See, M.P.E.P. §2143.)

Third, even if the rejection were properly supported by argument, Applicants submit that claim 8 recites elements not shown, taught, or suggested by Garber et al. and Markman, whether taken alone or in combination. Claim 8 reads as follows:

8. A method of interrogating RFID tags associated with items of interest, comprising the steps of:

- (a) selecting at least two categories of items using a user interface associated with an RFID reader;
- (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, wherein the item of interest is not currently associated with the categories selected in step (a); and
- (c) thereafter categorizing information related to the at least one item(s) associated with the interrogated RFID tag(s) obtained in step (b) with at least one of the categories selected in step (a).

As mentioned above, relative to Markman, the Office Action states that the group identification of each article is read by scanning a barcoded group code and article count and *the location of the group is located, which is considered as categorizing.* (emphasis added) Applicants disagree. Markman teaches that the garments to be cleaned are first categorized into a group, such as one customer's articles. Then, after the cleaning process, the garments are regrouped into their original group. Thus, the garment's category does not change. It does not matter that the garments are temporarily stored in a location while the group is being regrouped. During this process the garment's category remains the same – a group of one customer's articles. In contrast, claim 1 requires the steps of: (a) *selecting a category* of items using a user interface associated with an RFID reader; (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, *wherein the item of interest is not currently associated with the category selected in step (a);* and (c) *thereafter associating information related to the at least one item obtained in step (b) with the category selected in step (a).*

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Similarly, as discussed in the Office Action faxed on November 19, 2003, Garber et al. teaches a variety of functions, methods and applications, for example starting on column 16, line 32 and ending on column 18, line 54, *where the item of interest's category does not change* based on the function, method or application performed.

As a result, Markman or Garber et al., whether taken alone or in combination, do not teach a function, method, or application where a user is seeking to make an association between a new category and some item of interest that is not currently associated with that category, and thereafter associates the information related to the item of interest with the new category selected.

Thus, claim 8, recites elements not disclosed by Garber et al. or Markman, whether taken alone or in combination, and should be allowable. Claims 9-17, which depend from claim 8 and add further limitations, should also now be allowable. Therefore, Applicants respectfully request the rejection of claims 8-17 under 35 U.S.C. § 103(a) over Garber et al. in view of Markman be withdrawn.

In summary, the rejection of claims 1-17 under 35 USC § 103(a) as being unpatentable over Garber et al. in view of Markman has been overcome and should be withdrawn.

Claims 18-24: Claims 18-24 stand rejected under 35 USC § 103(a) as being unpatentable over Garber in view of Markman (US 5,794,213) and Harrison et al (US 6,176,425). Claim 18 was amended to correct a typo.

In the Office Action, Applicants believe the Examiner recognized that Garber et al. does not disclose the steps of: (a) *selecting at least one category* of items using a user interface associated with an RFID reader; and (c) *categorizing information related to the at least one item(s) associated with the interrogated RFID tag(s) in at least one of the categories*. In addition, Applicants believe the Examiner recognized that Garber et al. modified by Markman fails to teach the step of (d) ignoring any RFID-tagged-item that may not be categorized in at least one category.

Applicants believe claims 18-24 are allowable over Garber et al. in view of Markman and Harrison (U.S. Pat. No. 5,794,425) for the following reasons.

First, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of Markman and Harrison because there is no

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basis for combining Garber et al.'s devices, applications, and methods of using a portable RFID device with a group of items each having an RFID tag, with Markman's system and methods of sorting laundry and dry-cleaning, and then combine it with Harrison, which relates to a system for identifying multiple electronic tags where the multiple electronic tags are attached to a single item. There must be some suggestion in the prior art to make the combination. Absent such a showing in the prior art, the Applicants' teaching has been impermissibly used to hunt through the prior art for the claimed elements and combine them as claimed. (See, M.P.E.P. §2143.)

Second, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of Markman, because there is no reasoned statement that explains why it would have been obvious to one of ordinary skill in the art to have modified the system disclosed in Garber et al. to meet the limitations of claim 1. Instead, there is only a cursory statement that "[i]t would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Markman to the teaching of Garber . . . to relocate where the item belongs so that the item can be placed at its designated spot..." (Office Action at page 7), followed by another cursory statement "it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Harrison to the teaching of Garber as modified by Markman so that other unrelated tags are not associated with a certain category, and avoid any confusion to the user as well as to the program used in the interrogating equipment to properly perform the function. Accordingly, the applied rejection is believed to be faulty, and if the Examiner proposes to provide any reasoning supporting the rejection then Applicants respectfully request a second non-final Office Action be issued so that Applicants may learn what that reasoning is and reply to it. (See, M.P.E.P. §2143.)

Third, even if the rejection were properly supported by argument, Applicants submit that claim 18 recites elements not shown, taught, or suggested by Garber et al. in view of Markman and Harrison, whether taken alone or in combination. Claim 18 reads as follows:

18. A method of interrogating RFID tags associated with items of interest, comprising the steps of:

- (a) selecting at least one category of items using a user interface associated with an RFID reader;

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- (b) interrogating RFID tags associated with items, at least one of which is within the category of items;
- (c) categorizing information related to the at least one item(s) associated with the interrogated RFID tag(s) in at least one of the categories; and
- (d) ignoring any RFID-tagged-item that may not be categorized in at least one category.

As mentioned above, relative to Markman, the Office Action states that the group identification of each article is read by scanning a barcoded group code and article count and *the location of the group is located, which is considered as categorizing.* (emphasis added) Applicants disagree. Markman teaches that the garments to be cleaned are first categorized into a group, such as one customer's articles. Then, after the cleaning process, the garments are regrouped into their original group. Thus, the garment's category does not change. It does not matter that the garments are temporarily stored in a location while the group is being regrouped. During this process the garment's category remains the same – a group of one customer's articles. In contrast, claim 1 requires the steps of: (a) *selecting a category* of items using a user interface associated with an RFID reader; (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, *wherein the item of interest is not currently associated with the category selected in step (a);* and (c) thereafter *associating information related to the at least one item obtained in step (b) with the category selected in step (a).*

Similarly, as discussed in the Office Action faxed on November 19, 2003, Garber et al. teaches a variety of functions, methods and applications, for example starting on column 16, line 32 and ending on column 18, line 54, *where the item of interest's category does not change* based on the function, method or application performed.

In addition, the Examiner recognizes that Garber as modified by Markman fails to teach step (d) of claim 18: *ignoring any RFID-tagged item that may not be categorized in at least one category.*

Regarding Harrison, Applicants note that the Examiner did not respond to Applicants' arguments regarding claim 18 relative to Harrison presented in the Office Action Response faxed on November 19, 2003. Therefore Applicants' arguments regarding claim 18 relative to Harrison remain the same, and have been provided below for the Examiner's convenience. Accordingly, if

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the Examiner responds to the Applicants' arguments regarding claim 18 relative to Harrison, Applicants respectfully request a third non-final Office Action be issued, so that Applicants may learn what that the Examiner's response to Applicants' arguments is and reply to it.

In regard to Harrison, the Office Action stated that Harrison teaches that if a tag identification number is detected which is not associated with any semantics, the program can ignore the tag. Applicants note that we disagreed with this statement in the Office Action response faxed on November 19, 2003, but that the Examiner failed to supply her response to Applicants arguments. Applicants disagree. Harrison teaches the matching of a tag identification number to a specific function to be performed by a computer such as "to unlock an electronically controlled door, to display a graphical image on a computer display, or login into a computer network, etc." (See Column 10, Lines 13-37 of Harrison.) "After an electronic tag is read, the computer system 12 is used to interpret the identification number of the electronic tag and provide the requested digital service. Semantic binding of the identification number can be provided by a computer 14 ..." (See, Column 9, Lines 1-8 of Harrison.) "For example, a database format can be constructed in which each identification number of an electronic tag is a database key. Associated with that key is a set of digital actions to undertake when that identification number of an electronic tag is detected. There is an enumerated list of such actions – display a Web page, display a text document, display a date in a calendar, go to a certain location in a document, and so forth." (See, Column 9, Lines 28-35 of Harrison.) Therefore, it is clear that the segment of Harrison cited by the examiner does not teach that if an item to which an RFID tag is attached cannot be categorized into one of the categories that the operator has selected, that the act of categorizing the item can be ignored, as recited in claim 18. The teaching of Harrison to ignore an ID tag if there is no mapped computer command does not, can not teach that when one is categorizing items, that if an item does not fit into one of the categories into which a user is categorizing items, that the user need not categorize the item. Therefore, contrary to the Examiner's assertion that Harrison teaches element (d); the rejection is unsupported by the art and should be withdrawn.

As a result, claim 18 recites elements not disclosed by Garber et al. or Markman or Harrison, whether taken alone or in combination, and should be allowable. Claims 19-24, which depend from claim 18 and add further limitations, should also now be allowable. Therefore,

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Applicants respectfully request the rejection of claims 1-7 under 35 U.S.C. § 103(a) over Garber et al. in view of Markman and Harrison be withdrawn.

Dependent Claims 2-7, 9-17 and 19-24: Lastly, Applicants point out that the Examiner did not include any discussion in the Office Action regarding any of the dependent claims, claims 2-7, 9-17 and 19-24. The Office Action discussion was solely focused on only the independent claims. Therefore, there is no support for the obviousness rejection against claims 2-7, 9-17 and 19-24, which is insufficient under the current law. Therefore, the rejection against claims 2-7, 9-17 and 19-24 is unsupported by art and should be withdrawn.

Withdrawal of the outstanding rejection and allowance of the pending claims is respectfully requested. If a telephonic conference would be helpful in resolving any outstanding matters in the present application, the Examiner is encouraged to contact applicants' undersigned representative.

Respectfully submitted,

Date

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